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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/306,761	05/07/1999	JACK DENEBERG	12177/47501	3926

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WASHINGTON, DC 20005

EXAMINER

LE, LANA N

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/306,761

Applicant(s)

DENEBERG ET AL.

Examiner

Lana Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-13 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 11-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for performing the method steps, does not reasonably provide enablement for a program that requires more than routine experimentation, see MPEP §2106. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to the invention commensurate in scope with these claims. The specification does not disclose a detailed program software flow chart or psuedo computer language chart or a program written by an ordinary skilled programmer with reasonable experimentation. Therefore, the claimed language of a "program storage device" in claims 11-13 is inappropriate.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application

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being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1, 6, 8, 10-13 rejected under 35 U.S.C. 102(e) as being anticipated by Sonti (US 6,108,540).

Regarding claim 1, Sonti et al discloses a method for registering a mobile communication device to a service comprising:

receiving a device identifier (ESN field 358) for the mobile communication device via a communication network, wherein the device identifier is correlated with information concerning what services the mobile communication device has a technical capability to access (col 5, line 45 - col 6, line 23); accessing a device capabilities database that includes the information, using the received device identifier (col 5, lines 40-55, lines 3-11);

receiving, via the network, a request for a service to be provided to the mobile communication device (col 6, line 63 – col 7, line 24);

determining, based on the received device identifier and the corresponding information, whether the mobile communication device is capable of receiving the requested service (col 7, lines 12-20); and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 7, lines 20-24).

Regarding claim 6, Sonti et al discloses a method for registering a mobile communication device to a service, comprising:

receiving a device attribute for the mobile communication device via a communication network, wherein the device attribute (ESN field 358) is correlated with information concerning the technical capability of the mobile communication device to receive a requested service (col 5, line 45 – col 7, line 24);

receiving, via the network, a request for a service to be provided to the mobile communication device; accessing an attribute database that includes the information, using the received device attribute (col 5, lines 40-55); determining, based on the received device attribute and the corresponding information, whether the mobile communication device is capable of receiving the requested service (col 7, lines 12-20); and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 7, lines 20-24).

Regarding claim 8, Sonti et al further discloses the method of claim 6 wherein, said device attribute includes a home location identifier (location field; col 5, lines 31-37) to be associated with the mobile communication device; said attribute database including an indication of which home location identifiers correspond to geographic areas in which the service is receivable (col 5, lines 4-55); and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the home location of the mobile communication device corresponds to a geographic area in which the service is receivable (col 7, lines 14-24).

Regarding claim 10, Sonti et al discloses a method for ascertaining whether to register a mobile communication device to a given service, the method comprising: applying a device identifier to an equipment capabilities filter (ESN; col 5, lines 45-55), the equipment capabilities filter comprising information concerning what services the device has a technical capability to access (col 5, line 45 – col 6, line 23); applying a home location identifier to a geographic eligibility filter (location field; col 5, lines 31-36; col 6, lines 65-67); and registering the mobile communication device to the given service if the device identifier and home location identifier (loc field 310) pass through the equipment capabilities filter and geographic eligibility filter, respectively (col 7, lines 11-24).

Regarding claim 11, Sonti et al discloses a program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for registering a mobile communication device to a service (col 6, lines 62-65), the method comprising: receiving a device identifier for the mobile communication device via a communication network (col 7, lines 6-20), wherein the device identifier is correlated with information concerning what services the mobile communication device has a technical capability to access (col 7, lines 12-23); receiving, via the network, a request for a service to be provided to the mobile communication device (col 6, lines ; accessing a device capabilities database that includes the information, using the received device identifier (col 4, line 66 – col 5, line 12);

determining, based on the received device identifier and the corresponding information, whether the mobile communication device is capable of receiving the

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requested service (col 7, lines 12-24); and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 7, lines 21-24).

Regarding claim 12, Sonti et al discloses a program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for registering a mobile communications device to a service (col 6, lines 62-65), the method comprising: receiving a device attribute (ESN field 308) for the mobile communication device via a communication network, wherein the device attribute is correlated with information concerning the technical capability of the mobile communication device to receive a requested service (col 5, line 45 - col 6, line 23); receiving, via the network, a request for a service to be provided to the mobile communication device (col 5, lines 40-55); accessing an attribute database that includes the information, using the received device attribute; determining, based on the received device attribute and the corresponding information, whether the mobile communication device is capable of receiving the requested service (col 7, lines 13-24); and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 7, lines 13-24).

Regarding claim 13, Sonti et al discloses a program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for ascertaining whether to register a mobile communication device to a given service (col 6, lines 62-65), the method comprising:

applying a device identifier (ESN field 308) to an equipment capabilities filter, the equipment capabilities filter comprising information concerning what services the device has a technical capability to access (col 5, line 45 - col 6, line 23);

applying a home location identifier (Loc field) to a geographic eligibility filter (col 5, lines 31-37); and registering the mobile communication device to the given service if the device identifier and home location identifier pass through the equipment capabilities filter and geographic eligibility filter, respectively (col 7, lines 14-24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti et al in view of Saunders et al (US 5,918,172).

Regarding claim 3, Sonti et al further discloses the method of claim 1 wherein Sonti et al didn't further disclose the requested service comprises a billing plan for communications using the mobile communication device. Saunders et al further discloses the method of claim 1 wherein the requested service comprises a billing plan for communications using the mobile communication device (col 4, lines 18-24). It would have been obvious to one of ordinary skill in the art at the time the invention was

made to implement a billing plan to Sonti et al in order to charge the mobile user for the type or amount of service requested.

3. Claims 4, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti et al (US 6,108,540) in view of Fehnel (WO 97/34438).

Regarding claim 4, Sonti et al discloses the method of claim 1 wherein Sonti et al didn't further disclose the device capabilities database stores information about whether the mobile communication device is a multi-network phone and the mobile communication device is determined to be capable of receiving the service when the device capabilities database indicates that the mobile communications device is a multi-network phone. Fehnel further discloses the method of claim 1 wherein the device capabilities database stores information about whether the mobile communication device is a multi-network phone and the mobile communication device is determined to be capable of receiving the service when the device capabilities database indicates that the mobile communications device is a multi-network phone (page 19, line 19 – page 20, line 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store information along with the ESN field of Sonti et al about the whether the phone is a multi-network phone in order to verify if the mobile device is able to access the particular feature of service based on the equipment detail.

Regarding claim 7, Sonti et al further discloses the method of claim 6 wherein, Sonti et al didn't further disclose said device attribute comprises an electronic serial number (ESN) associated with the device, said attribute database including an indication of whether a device having a particular ESN is a multi-network phone; and the

mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the device is a multi-network phone. Fehnel further discloses said device attribute comprises an electronic serial number (ESN) associated with the device, said attribute database including an indication of whether a device having a particular ESN is a multi-network phone; and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the device is a multi-network phone (page 19, line 19 – page 20, line 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store information along with the ESN field of Sonti et al about the whether the phone is a multi-network phone in order to verify if the mobile device is able to get the particular feature in the list of services based on the equipment's detail.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti et al in view of Fehnel as applied to claim 4 above and further in view of Saunders et al (US 5,918,172).

Regarding claim 5, Sonti et al and Fehnel didn't further disclose the method of claim 4 wherein the requested service comprises a billing plan for communications using the mobile communication device. Saunders et al further discloses the method of claim 1 wherein the requested service comprises a billing plan for communications using the mobile communication device (col 4, lines 18-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a billing plan to Sonti et al and Fehnel in order to charge the user based on the finding out

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of whether the electronic serial number field supports the digital/analog able phone's services.

Allowable Subject Matter

5. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 2, the cited prior art fails to further disclose the method of claim 1 wherein when it is determined that the communication device is not capable of receiving the requested service, proposing an alternative service to the party that requested service wherein the alternative service is compatible with the mobile communication device.

Conclusion

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

or:

(for informal or draft communications, please label

"PROPOSED" or "DRAFT"

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Hand-delivered responses should be brought to the Crystal Park II, 2021 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

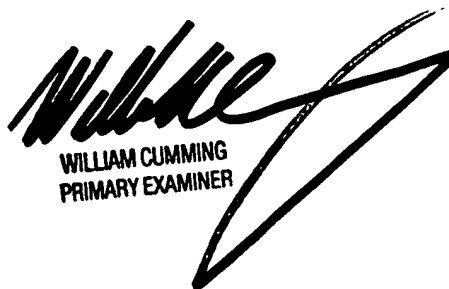
Any inquiry concerning this communication or communications from the examiner should be directed to Lana Le whose telephone number is (703) 308-5836 and to the supervisory patent examiner Daniel Hunter whose telephone number is (703) 308-6732.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-6750.

L.L.

Lana Le

February 18, 2003


WILLIAM CUMMING
PRIMARY EXAMINER